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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,555

08/05/2003

Takashi Ohno

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EXAMINER

WHIPPLE, BRIAN P

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,555	Applicant(s) OHNO ET AL.	
	Examiner Brian P. Whipple	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/20/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 and 13-14 are pending in this application and presented for examination.

Response to Arguments

2. Applicant's arguments, see page 7, filed 6/24/08, with respect to the 35 U.S.C. 101 rejection of claim 12 and the 35 U.S.C. 112 rejection of claim 13, have been fully considered and are persuasive. The aforementioned rejections of claims 12 and 13 have been withdrawn.

3. Applicant's discussion, see page 7, filed 6/24/08, with respect to the 35 U.S.C. 112 rejection of claim 2, has been fully considered but is not persuasive.

Applicant has failed to address (via argument or proper amendment) Examiner's exception to the lack of the language "further comprising" or "are", as discussed below in the corresponding 35 U.S.C. 112, second paragraph rejection of claim 2. Examiner maintains the language of the limitation is grammatically incorrect and vague enough to cause confusion that rises to the level of being properly rejected under 35 U.S.C. 112, second paragraph.

4. Applicant's arguments, see page 8, filed 6/24/08, with respect to the 35 U.S.C. 102 rejection of claim 1 (and its dependent claims 2-9), have been fully considered but they are not persuasive.

Neither the language of the claim itself or the cited portion of the specification (page 23, lines 5-12) lead the Examiner to the conclusion that the language is equivalent to the Applicant's description, "re-register a watcher associated with a user when the user changes his or her used ID."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "re-register a watcher associated with a user when the user changes his or her used ID") are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicant's argument, see page 8, filed 6/24/08, with respect to the 35 U.S.C. 102 rejections of claims 10-11 and 13-14, has been fully considered but is not persuasive. The claims are not patentably distinguishable over Sugano et al. for the reasons discussed above.

6. Applicant's argument, see page 8, filed 6/24/08, with respect to the 35 U.S.C. 102 rejection of claim 14, has been fully considered but is not persuasive.

Firstly, the recitation "instant messaging administration method" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not

accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Secondly, while Examiner need not cite a portion of Sugano, it is brought to Applicant's attention that Sugano et al. does discuss instant messaging (Col. 10, ln. 42-59, "Internet Relay Chat").

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-2 and 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. As to claim 1, it is unclear to the Examiner how "all watcher clients of the first client [can be] one identifier notification recipient." In other words, the claim originally reference

one or more of the watcher clients being indicated as one or more identifier notification recipients. Now the amended claim reads that **all** watcher clients are **one or more** identifier notification recipients. This is contradictory language. Furthermore, if **all** watcher clients are to be identifier notification recipients, it is unclear to the Examiner how this can be seen as "a decision step" as there are essentially no alternatives to decide between, as **all** watcher clients are referenced. The Examiner suggests Applicant go back to the language originally used or a suitable alternative.

10. As to claims 10-11, the claims are rejected for reasons similar to claim 1 above.

11. As to claims 1, 10-11, and 13, and their common language of "storing the same", the phrase lacks antecedent basis. Additionally, it is unclear if "the same" refers to the correlation, the new identifier of the first client, the identifier of the identifier notification recipient, or some combination of the three.

12. As to claim 2, the meaning of "the decision step deciding all of a plurality of watcher clients of the first client to be identifier notification recipients according to the change of the identifier of the first client" is unclear. The examiner interpreted this as "the decision step **further comprising** deciding watcher clients of the first client or at least one of a plurality of

watcher clients of the first client **are** to be identifier notification recipients according to the change of the identifier of the first client” for the purposes of this examination.

Additionally, the amendments made to claims 1 and 2 raise a new issue related to claim 2 being vague and indefinite. If “all” of the watcher clients were designated as identifier notification recipients in claim 1, it is unclear how "at least one" (implying anywhere from one to all) can then be designated in claim 2, since “all” were already designated in the parent claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugano et al. (Sugano), U.S. Patent No. 6,205,478 B1.

15. As to claim 1, Sugano discloses a client administration method of administering a group of clients (Abstract, ln. 1-3),

each client providing presence information (Col. 7, ln. 47-49), the method comprising:

a presence-storing step of accepting a setting of presence information of the clients including a first client, and storing the presence information client by client (Col. 7, ln. 40-43 and 47-49; Col. 19, ln. 2-6);

a notification recipient-storing step of storing identifiers of watcher clients for respective clients, each of the watcher clients being provided with the presence information of at least one of the clients in the clients group (Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66);

an identifier-changing step of accepting a change of an identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25);

a decision step of deciding all watcher clients of the first client to be one or more identifier notification recipients according to the change of the identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25; Col. 23, ln. 36-43);

an identifier-transmitting step of transmitting a new identifier of the first client to one or more identifier notification recipients decided in said decision step (Col. 22, ln. 6-18; Col. 23, ln. 36-43), and

a notification recipient updating step of accepting a request for a change notification of presence information of the new identifier of the first client from the identifier notification recipient (Col. 19, ln. 12-16 and 19-23; Col. 27, ln. 10-16 and 23-29),

correlating the new identifier of the first client and the identifier of the identifier notification recipient and store the same (Fig. 1, item 4; Fig. 2; Fig. 7, item 13; Col. 16, ln. 65 – Col. 17, ln. 3; Col. 22, ln. 19-22; Col. 29, ln. 34-43).

16. As to claim 2, Sugano discloses deciding watcher clients of the first client or at least one of a plurality of watcher clients of the first client are to be identifier notification recipients according to the change of the identifier of the first client (Col. 18, ln. 4-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users).

17. As to claim 3, Sugano discloses a subscriber client-storing step of storing identifiers of subscriber clients so that each subscriber client is associated with at least one client that provides the presence information thereto, the subscriber client being provided with the presence information of at least one client of the clients group (Col. 7, ln. 47-49; Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66); and

said decision step deciding a client to be an identifier notification recipient, the client being both a watcher client of the first client and a subscriber client of the first client (Col. 23, ln. 36-43).

18. As to claim 4, Sugano discloses a presence-notifying step of notifying the first client's watcher client of new presence information according to the setting of the presence information (Col. 7, ln. 47-49; Col. 26, ln. 12-41);

a notification history-storing step of storing a notification history of the presence information (Col. 9, ln. 25-29; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said decision step extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users who previously received a corresponding transmitted UIO; transmitting based on previous recipients is a decision step based on notification history).

19. As to claim 5, Sugano discloses a messaging step of administering distribution of text messages exchanged between the clients (Fig. 3; Col. 21, ln. 39-48);

a distribution history step of storing a distribution history of distributed text messages (Fig. 3; Fig. 4; Col. 9, ln. 25-29; Col. 18, ln. 10-14; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and said decision step extracting at least one of a plurality of watcher clients of the first client based on the distribution history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; transmitting based on previous recipients is a decision step based on distribution history).

20. As to claim 6, Sugano discloses said presence-storing step storing the presence information of the clients so that the presence information is associated with an access level, the access level limiting notification recipients of the presence information of the clients (Col. 19, ln. 63-67; Col. 20, ln. 1-15);

said notification recipient-storing step further storing the access level of each watcher client (Col. 19, ln. 63-67; Col. 20, ln. 1-5); and

said decision step deciding a portion of a plurality of watcher clients of the first client to be the identifier notification recipients based on the access level of each watcher client (Col. 20, ln. 30-61; Level 5 users are not issued a UIO and no items are accessible).

21. As to claim 7, Sugano discloses transmitting display data for displaying the change of the identifier of the first client to one or more identifier notification recipients (Col. 25, ln. 19-36).

22. As to claim 8, Sugano discloses transmitting attribute information related to the change of the identifier of the first client to one or more identifier notification recipients (Fig. 3; Col. 22, ln. 6-18).

23. As to claim 9, Sugano discloses said identifier-changing step accepting registration of the attribute information (Col. 22, ln. 19-22).

24. As to claims 10-11, and 14, the claims are rejected for reasons similar to claim 1 above.

25. As to claim 13, Sugano discloses a client administration method of administering a group of clients (Abstract, ln. 1-3),

each client providing presence information (Col. 7, ln. 47-49), the method comprising:

accepting a setting of presence information of the clients including a first client, and storing the presence information client by client (Col. 7, ln. 40-43 and 47-54; Col. 19, ln. 2-6);

storing client-relationship information for respective clients, the client-relationship information containing at least one identifiers of one or more clients relating to provision of presence information of the first client thereto and one or more identifiers of one or more clients relating to a request made by the first client, the request being for provision of presence information of those clients to the first client (Col. 29, ln. 4-43);

accepting a change of an identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25);

deciding one or more clients to be one or more identifier notification recipients according to the change of the identifier of the first client, one or more identifiers of one or more clients being contained in the client relationship information stored in association with the first client (Fig. 2, item 7; Col. 19, ln. 12-25; Col. 23, ln. 36-43);

transmitting a new identifier of the first client to one or more identifier notification recipients decided in said decision step (Col. 22, ln. 6-18; Col. 23, ln. 36-43), and

accepting a request for a change notification of presence information of the new identifier of the first client from the identifier notification recipient (Col. 19, ln. 12-16 and 19-23; Col. 27, ln. 10-16 and 23-29),

correlating the new identifier of the first client and the identifier of the identifier notification recipient and store the same (Fig. 1, item 4; Fig. 2; Fig. 7, item 13; Col. 16, ln. 65 – Col. 17, ln. 3; Col. 22, ln. 19-22; Col. 29, ln. 34-43).

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2152

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9/7/08

/Kenny S Lin/
Primary Examiner, Art Unit 2152